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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/502,875 02/11/00 MARTIN

J 10527US15

EXAMINER

TM02/0731

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34th floor  
Chicago IL 60661

HEWITT, L.L.C.

ART UNIT

PAPER NUMBER

2161

**DATE MAILED:**

07/31/01

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/502,875	MARTIN ET AL.
	Examiner	Art Unit
	Calvin L Hewitt II	2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 May 2001.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) \_\_\_\_\_ is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 30,31,39,46,47 and 51 is/are allowed.

6) Claim(s) 27-29,32-38,40-45,48-50,52 and 53 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

18) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

19) Notice of Informal Patent Application (PTO-152)

20) Other: \_\_\_\_\_

*Status of Claims*

1. Claims 27-52 have been examined.

*Response to Arguments*

2. The Applicant disputes the merits of the Examiner's Double "Patenting Rejection" as applied to claims 27-52. In particular, the Applicant points out that the claims of the '889 Patent do not sufficiently teach "song identity" and that the quote "means for displaying" is not to be found in the present application. The Examiner respectfully disagrees on both accounts. Claim 1 refers to, "... song identity data, which represents the identity of each such song" and "means for displaying, ... information that identifies the songs for which song digital data is stored in the computer memory...". With regards to the term "song identity data", it is defined in column 7, lines 33-36 of the '889 Patent; the processing circuit **identifies** song data from the song address field of the song record. Finally, the Examiner would like to point out to the Applicant that the claims 27, 35, 41 and 48 use the language "at least one of..." therefore, the Claim 1 phrase, "... song identity data, which represents the identity of each such song", is sufficient. With regards to "means for displaying", claims 28 and 41 teach "a display presenting song selections" while claim 48 teaches "presenting song selections

based on the song identity data on a display". In claim 35, the Examiner regards a display as inherent. In order to distribute the digitized song data to a computer jukebox the central management system retrieves the digitized selected song (claim 35, paragraph four). Therefore, it necessarily follows that a user selected the song via the aforementioned computer jukebox in order to initiate the communication with the central management system. Jukeboxes have displays and such a display would have allowed the user to peruse the songs available and to identify and select a desired song. Based on the above discussion, the Examiner maintains the Double Patenting rejection as applied to claims 27-29, 32-38, 40-45, 48-50, 52, 53.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 27-29, 32-38, 40-45, 48-50, 52, 53 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of prior U.S. Patent No. 5,781,889. This is a double patenting rejection.

As per claims 27, 35, 41 and 48, the claims in U.S. Patent No. 5,781,889 discloses a computer jukebox network with computer jukeboxes and central management system comprising:

- plurality of computer jukeboxes (claim 7, column 9, lines 39-50; claim 11, column 10, lines 56-59)
- a central management system (claim 7, column 10, line 25)
- a communication interface for receiving a digitized song and song identity information (claim 1, column 8, lines 28-30; claim 7, column 10, lines 25- 41; claim 8, column 10, lines 41-45; claim 13, column 12, lines 7-10)

- a memory for storing song data, such as play count, and identity (claim 1, column 8, lines 30-33; claim 7, column 9, lines 39-57; claim 7, column 10, lines 29-37; claim 11, column 10, lines 55-60)
- a display presenting song selections based on song id (claim 1, column 8, lines 34-37; claim 7, column 9, lines 58-61)
- a song selector (claim 1, column 8, lines 38-42; claim 7, column 9, lines 39-50 and 62-66)
- an audio speaker (claim 1, column 8, line 44; claim 7, column 9, line 67)
- a processor to store and enable song selection (claim 1, column 8, lines 45-65; claim 7, column 10, lines 5-24 and 27-40)
- a digital to analog converter (claim 1, column 8, line 45; claim 7, column 10, lines 2-5).

As per claims 28, 36 and 49, the claims in U.S. Patent No. 5,781,889 discloses digitized song libraries and song catalogs (claim 7, column 9, lines 39-57 and column 10, lines 26-37).

As per claims 29 and 50, the claims in U.S. Patent No. 5,781,889 discloses display means and for generating a signal representing the song selected by the user (claim 7, column 9, lines 39-67).

As per claim 32, the claims in U.S. Patent No. 5,781,889 discloses the displaying of graphics associated with a song that are used to attract customers (claim 1, column 8, lines 34-37; claim 4, column 9, lines 13-19; claim 7, column 9, lines 55-61).

As per claims 33, 34, 44, 45 and 52, the claims in U.S. Patent No. 5,781,889 provides for the creation of song play counts and money intake data as well as the relaying of said data to a remote accounting location (claim 1, column 8, lines 48-65; claim 2, column 9, lines 5-7; claim 6, column 9, lines 28-38; claim 8, column 10, lines 41-45; claim 11, column 10, lines 56-67; claim 13).

As per claim 37, the claims in U.S. Patent No. 5,781,889 discloses a central management system that stores and transmits song id and associated graphic data (claim 1, column 8, lines 34-37; claim 3, column 9, lines 8-13; claim 7, column 9, lines 55-61).

As per claims 38 and 43, the claims in U.S. Patent No. 5,781,889 discloses a central management system to receive play count and money intake data from a computer jukebox (claim 2, column 9, lines 1-7; claim 6, column 9, lines 27-38; claim 7, column 10, lines 25-40; claim 11, column 10, lines 56-67; claim 13, column 12, lines 1-10).

As per claims 40, 42 and 52, the claims in U.S. Patent No. 5,781,889 discloses a process for determining whether a song should be replaced based on song usage data and the updating of the jukebox song library (claim 1, column 8, lines 58-65; claim 2, column 8, lines 65-67 and column 9, lines 1-7; claim 12, column 11, lines 1-8).

*Allowable Subject Matter*

5. Claims 30, 31, 39, 46, 47 and 51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
  - Glick et al. teach a computing and multimedia entertainment system
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The examiner can normally be reached on Monday-Friday from 8:30 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to"

Commissioner of Patents and Trademarks

C/o Technology Center 2700

Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

or:

(703) 308-5397 (for informal or draft communications, please label

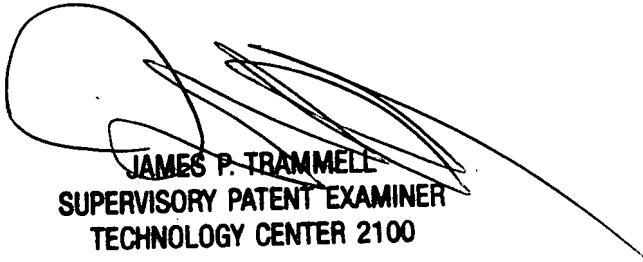
“PROPOSED” or “DRAFT”)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should  
be directed to the Group receptionist whose telephone number is (703) 305-3900.

Calvin Loyd Hewitt II

July 25, 2001

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100